

**REMARKS**

The foregoing amendment is in response to the Office Action mailed July 12, 2001. Applicant wishes to thank the Examiner for courtesies extended in an interview at the U.S. Patent and Trademark Office on November 6, 2002. Applicant agrees that the interview summary prepared by the Examiner sets forth the substance of that interview.

Applicant has carefully considered the Office Action and has also carefully reviewed the *Wei* patent prior to making the foregoing amendments, which are believed to place this application in condition for allowance, as explained more fully in the following remarks.

With respect to paragraphs 1 and 2 of the Office Action, applicant acknowledges the necessity of surrendering the original patent, and also agrees that a Supplemental Oath will be necessary, when prosecution indicates that all errors have been corrected to the satisfaction of the applicant and the Examiner.

With respect to paragraph 3 of the Office Action, a new Supplemental Affidavit of Vasudeva is submitted herewith, which clearly states that Mr. Wei was under an obligation to assign the patent rights to Maxtech at the time the invention was made.

With respect to paragraph 4 of the Office Action wherein claims 1-16 are rejected under 35 U.S.C. 112, first paragraph, applicant appreciates the Examiner's care in reviewing the specification and in noting the following:

More specifically, claim 1 inaccurately calls for the sliding plates (17) to be slidably disposed to the two side walls (12, 12). While the detailed description of the specification discloses one sliding plate 17 as being slidably disposed with respect to one side wall 12, it discloses the other sliding plate 17 as being slidably

disposed with respect to the separating board 11 (Col. 2, lines 17-28), which is not a side wall within the meaning of Applicant's disclosure. In agreement with the detailed description, the drawings (see Figure 2) show that only one of the side walls 12 has a sliding plate 17 positioned adjacent thereto; the other does not.

Moreover, the SUMMARY OF THE INVENTION, like the claims, inaccurately calls for the sliding plates to be slidably disposed to the two side walls and therefore fails to summarize the invention that is described in the DESCRIPTION OF THE PREFERRED EMBODIMENTS and that is shown in the drawings.

The foregoing amendments to the specification and drawing correct these errors. The sliding plate disposed to the separating board is given its own reference numeral 17a, and the apertures in sliding member 17a are given reference numeral 18a. The apertures in the separating board are given the reference numeral 13a and the second side wall is given its own reference numeral 12a (The proposed drawing amendment attached hereto implements these new reference numerals.). The written description has also been amended to reflect and more precisely set forth that one sliding plate, namely sliding plate 17, is disposed to one side wall 12.

The specification was also amended to correct the number of the bottom of the base from 13 to 100 as shown in the drawing.

The correction has also been carried over to the foregoing amendment of claim 1. Original claim 1 called for two sliding plates respectively and slidably disposed to the side walls; however, as the Office Action correctly points out "... the detailed description of the specification discloses one sliding plate 17 as being slidably disposed with respect to one side

wall 12 . . .” (emphasis in the Office Action). Thus, claim 1 and the claims dependent therefrom now call for one sliding plate slidably disposed to one side wall, as described and supported in the drawings and detailed specification.

With respect to claim 9 and its dependent claims, the Office Action asserts new matter is claimed in the limitation “at least one sliding plate” in claim 9 since the original disclosure did not consider, suggest or disclose the use of only one sliding plate for connection to the receiving members. Applicant traverses this rejection and also notes that claim 9 has been amended to call for one sliding plate slidably disposed to one side wall as shown in the drawings and described in the detailed specification. Although the specification discloses a second sliding plate, it is not slidably disposed adjacent a side wall. Therefore, claiming one sliding plate slidably disposed adjacent to one side wall is not new matter, but merely an accurate expression of what is shown in the drawing and specification, and specifically acknowledged in the Office Action.

Furthermore, even though the receiving members are shown as being connected by a second sliding plate, that second sliding plate is not necessary to achieve the desired pivoting motion of the receiving members, therefore, its inclusion in the claims is superfluous with respect to an operable device and requiring its inclusion in a claim would also require the applicant to claim less than he had a right to claim.

The cases cited in the Office Action are not on point as requiring a different conclusion. The Office Action cites United States Industrial Chemicals, Inc. v. Carbide and Carbon Chemicals Corp., 315 U.S. 668, 53 USPQ 6 (1942), and the Gentry Gallery, Inc. v. The Berkline Corp., 45 USPQ 2d 1498 (Fed. Cir. 1998) are cited for the proposition that new matter may exist by virtue of the omission of a feature. In the United States Industrial Chemicals, a reissue

applicant eliminated a method step that was repeatedly described as essential to the invention and claimed in the original patent. The operation of the method was essentially changed by the omission. The Court held that the invention was thereby different. In the present case, the second sliding plate is not essential to an operable structure, and the structure operates in the same manner with or without the second sliding plate. Furthermore, what is removed from claim 1 is a sliding plate slidably disposed to a second side wall, which the Office Action correctly notes was an error in the original claim. The amendments to the claims therefore corrects an error rather than omits an essential element of the claims, and correction of errors is the precise purpose of the reissue statute.

The facts in this application also do not fall within the principles of *in re: Gentry*. *In re: Gentry*, the specification described controls positioned on a console and no other location. The Court held that the patent disclosure did not support claims that were located in a position other than on the console. In the present application, the claims call for a sliding plate slidably disposed to a side wall, i.e. in the precise location and relationship of the sliding plate and side wall set forth in the specification and shown in the drawing, unlike the *In re: Gentry* situation.

With respect to paragraph 5 of the Office Action, the dependency of claim 6 is corrected by the foregoing amendment, which also obviates the rejection of claim 7. This amendment was inadvertently omitted from the last response. Claim 11 has also been amended to obviate any indefiniteness.

In paragraph 7 of the Office Action, claims 9-16 are rejected under 35 U.S.C. 102(e) as being anticipated by *Vasudeva* 5,803,254. *Vasudeva* '254 discloses a structure wherein a plurality of receiving members are mounted in a recess in the underside of a box portion of a tool

case. When the storage compartments or containers are in the closed position, their outer faces form a single plane which is flush with and parallel to the bottom of the box portion. Thus, the storage compartments or containers are not accessed through a cover.

Claim 9 has been amended to specify a means pivotally mounted to the base and pivotal between a closed position for covering the receiving members and an open position for permitting access to the receiving members. This means for covering is not present in *Vasudeva* '254, wherein claims 9, as amended, and claims 10-16 dependent therefrom are not anticipated by *Vasudeva* '254. In view of the Supplemental Affidavit of *Vasudeva* filed herewith, the *Vasudeva* '254 patent is not available as a reference under 35 U.S.C. 103.

With respect to paragraph 8 of the Office Action, claims 1 and 8-16 are rejected under 35 U.S.C. 102(b) as being anticipated by *Howard* U.S. Patent 4,531,646. At the outset, applicant notes that the *Howard* '646 patent is directed toward a stationary display rack especially designed to maximize access to articles held therein, whereas applicant's device is a tool box which can be closed and is portable to move the tools from place to place.

With respect to the rejection of claim 1 as being anticipated, both independent claim 1 and 9 have been amended to include means for covering the receiving members, which are not shown in *Howard* '646. Furthermore, it would not be obvious to provide *Howard* '646 with a cover means, as it would obviate the stated purpose of the *Howard* display rack, namely, of providing maximum access to the trays for loading and dispensing articles at the point of sale. Therefore, claims 1 and 9, and 8 and the dependent claims 10-16 dependent therefrom are believed patentable over *Howard*.

With respect to paragraphs 9 and 10 of the Office Action, they set forth an obviousness rejection over *Vasudeva* '254. This rejection is believed obviated by the Supplemental Affidavit of Vasudeva submitted herewith.

Applicant appreciates the acknowledgment of allowable subject matter in claims 3-7, and believes the remaining claims are also allowable in view of the foregoing amendments.

Status of Claims and Support for Claim Changes is attached herewith.

Respectfully submitted,

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**Status of Claims and Support for Claim Changes**

- Claim 1. Pending and now twice amended by adding means for covering. Support in original specification and claims. Now claims one sliding plate slidably disposed to one side wall to correct error. Support in that original specification and drawing show only one sliding plate slidably disposed to one side wall.
- Claim 2. Now canceled.
- Claims 3-5. No changes.
- Claim 6. Amended to delete reference to claim 2, now canceled.
- Claims 7&8. No changes.
- Claim 9. Filed with reissue application and pending. Now twice amended as shown below, wherein only the deletions with respect to the claim as filed are in brackets and only the additions with respect to the claim as filed are underlined:
9. (Twice Amended) A tool box comprising:
- a base portion having a back wall and at least two spaced-apart generally parallel walls extending from the back wall;
- one actuating member and at least [two] one receiving member[s] pivotally mounted [between] to one of said [two] generally parallel walls at respective pivot points spaced from the back wall and extending toward the other of said two generally parallel walls; [and]
- [at least one] a sliding plate connecting the actuating member and the at least [two] one said receiving member[s] at end locations on said activating member and at least one receiving member[s] displaced from said respective pivot points,

whereby rotation of [one] said [receiving] actuating member produces  
corresponding rotation of [any other] said at least one receiving member so  
connected by said sliding plate; and  
means pivotally mounted to said base and pivotal between a first, closed position  
for covering the at least one receiving member, and an open position for  
exposing the at least one receiving member.

Support in the drawing and specification.

Claim 10. Pending, no change.

Claim 11. Pending and Amended, as follows:

11. (Amended) A tool box as defined in claim 9, wherein one of said  
generally parallel walls is a first side wall of said base portion and the other said  
generally parallel wall is a separating board having a first portion spaced a distance  
from the first side wall and an extending portion spaced a greater distance from the  
first side wall.

Support in Specification.

Claims 12-16. Pending, no change.